

SUBJECT: DECISION ON TERMINAL DISCLAIMER INFORMAL FORM

DATE: 9/16/03

APPL. S.N.: 09, 454,737

TO EXAMINER: C420

ART UNIT: 1636

ROOM _____

MAILROOM DATE 7/10/03

AFTER FINAL YES _____ NO ☒ NUMBER OF T.D(S). FILED _____

INSTRUCTIONS: I have reviewed the submitted T.D. with the results as set forth below. If you agree, please use the appropriate form paragraphs identified by this Informal memo in your next office action to notify applicant about the T.D. If you disagree with my analysis or have questions at all about the acceptability of the T.D., please see me or our Special Program Examiner. THIS MEMO IS AN INFORMAL, INTERNAL MEMO ONLY. IT MUST NOT BE MAILED TO APPLICANT, NOR SHOULD A COPY BE LEFT IN FILE.

☒ The T.D. is PROPER and has been recorded. (See 14.23).

☐ The T.D. is NOT PROPER and has not been accepted for the reason(s) checked below. (See 14.24).

☐ The recording fee of \$ _____ has not been submitted nor is there any pre authorization in the application file to charge to a deposit account. (See 14.26.07)

☐ Application Examiner has not processed T.D. fee. (See fee authorization).

☐ The T.D. does not satisfy Rule 321(b)(3) in that the person who has signed the T.D. has not stated his/her interest (and/or the extent of the interest of the business entity represented by the signature) in the application/patent. (See 14.26 and 14.26.01).

☐ The T.D. lacks the enforceable only during the common ownership clause needed to overcome a double patenting rejection, Rule 321(c). (See 14.27, 14.27.01).

☐ It is directed to a particular claims(s), which is not acceptable since "the disclaimer must be of a terminal portion of the term of the entire patent to be granted". MPEP 1490. (See 14.26, 14.26.02).

☐ The person who signed the terminal disclaimer:

☐ has failed to state his/her capacity to sign for the business entity, (See 14.28).

☐ is not recognized as an officer of the assignee, (See 14.29 and possibly 14.29.01).

☐ No documentary evidence of a chain of title from the original inventor(s) to assignee has been submitted, nor is the reel and frame specified as to where such evidence is recorded in the office. 37 CFR 3.73(b). (See 1140 O.G. 72). **NOTE:** This documentary evidence or the specifying of the reel and frame may be found in the T.D. or in a separate paper submitted by applicant. (See 14.30).

☐ No "statement" specifying that the evidentiary documents have been reviewed and that, to the best of the assignee's knowledge and belief the title is in the assignee seeking to take action. 37 CFR 3.73(b). (See 1140 O.G. 72) (See 14.31).

☐ The T.D. is not signed. (See 14.26, 14.26.3). or 14.26.03 if TD is not signed by all the owners.

☐ Attorney not of record in oath/decl, or a separate paper filed appointing a new or associate attorney. (See 14.29.01).

☐ The serial number of the application (or the number of the patent) which forms the basis for the double patenting is missing or incorrect. (See 14.32).

☐ The serial number of this application (or the number of the patent in reexam or reissue case(s) being disclaimed is missing or incorrect. (See 14.26, 14.26.04 or 14.26.05).

☐ The period disclaimed is incorrect or not specified. (See 14.27, 14.27.2 or 14.27.3)(For Samples 14.27.04 and 14.27.05)

☐ Other: _____

☐ Suggestion to request refund of \$ _____. (See 14.35, 14.36).

EXAMINER NOTE: IF APPLICATION IS IN CONDITION FOR ALLOWANCE ANY OF THE ABOVE INFORMALTIES MAY BE FAXED IN TO THE GROUP

FOR SAMPLE TERMINAL DISCLAIMERS AND CERTIFICATES:

☐ Sample of a TD over a pending application and assignee Certificate (See 14.37).

☐ Sample of a TD over a prior patent and assignee Certificate (See 14.38).

☐ Sample Assignee Certificate under 37 CFR 3.73 (b) (See 14.39)



S/N 09/454,737

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	PERRICAUDET ET AL.	Examiner:	D. GUZO
Serial No.:	09/454,737	Group Art Unit:	1636
Filed:	DECEMBER 6, 1999	Docket No.:	8076.85USC1
Customer No.:	23352	Confirmation No.:	4183
Title:	VIRAL RECOMBINANT VECTORS FOR EXPRESSION IN MUSCLE CELLS		

#33

CERTIFICATE UNDER 37 CFR 1.10:

"Express Mail" mailing label number: EV 347834558 US

Date of Deposit: July 10, 2003

I hereby certify that this paper or fee is being deposited with the U.S. Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

By:

Sheryl A. Boerboom

Name: Sheryl A. Boerboom

TERMINAL DISCLAIMER TO OBVIATE
A DOUBLE PATENTING REJECTION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Petitioner, CENTRE NATIONAL DE LA RECHERCHE SCIENTIFIQUE, a corporation organized and existing under the laws of the Country of France, and having its primary place of business in the City of Paris, and the Country of France, represents that it is the owner of the entire right, title and interest in U.S. Patent Application Serial No. 09/454,737, filed on December 6, 1999 and entitled VIRAL RECOMBINANT VECTORS FOR EXPRESSION IN MUSCLE CELLS, by virtue of an assignment of the parent application Serial No. 08/070,325 recorded at Reel 6776, Frame 0149. (Copy of the Assignment attached.)

Petitioner, CENTRE NATIONAL DE LA RECHERSCHE SCIENTIFIQUE, hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the above-identified application, which would extend beyond the expiration date of the full statutory term of U.S. Patent No. 6,099,831 and hereby agrees that any patent so granted on the above-identified application shall be enforceable only for and during such period that the legal title to said patent shall be the same as the legal title to U.S. Patent No. 6,099,831, this agreement to run with any patent granted on the above-identified application and to be binding upon the grantee, its successors, or assigns.

In making the above disclaimer, Petitioner does not disclaim the terminal part of any patent granted on the above-identified application that would extend to the full statutory term as presently shortened by any terminal disclaimer of United States Patent No. 6,099,831, in the event that United States Patent No. 6,099,831 expires for failure to pay a maintenance fee, is held unenforceable, is found invalid, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321(a), has all claims cancelled by a reexamination certification, or is otherwise terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer, except for the separation of legal title stated above.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any

patent issued thereon.

Respectfully submitted,

MERCHANT & GOULD P.C.
P.O. Box 2903
Minneapolis, Minnesota 55402-0903
(612) 332-5300

ATTORNEYS FOR APPLICANT

Date July 10, 2003

By Katherine M. Kowalchuk
Katherine M. Kowalchuk
Reg. No. 36,848
(612) 371-5311



THE STATEMENT BELOW IS FOR OFFICE USE ONLY

In accordance with the decision granting the petition filed on _____, _____,
this terminal disclaimer is accepted. The period of patent lapse specified above has been
accepted as equivalent to _____ months.

Petitions Examiner



23552

PATENT TRADEMARK OFFICE



RECORDATION FORM COVER SHEET PATENTS ONLY

U.S. DEPARTMENT OF COMMERCE
Patent and Trademark Office

To the Commissioner of Patents and Trademarks: Please record the attached original documents or copy thereof.

1. Name of conveying party(ies):

Michel Ferricand
Michel Ferricand
Michel Ferricand

Name and address of receiving party(ies):

Name: Centre National de la Recherche Scientifique

Internal Address:

Additional name(s) of conveying party(ies) attached? ☐ Yes ☒ No

2. Nature of conveyance:

☒ Assignment

☐ Merger

☐ Security Agreement

☐ Change of Name

☐ Other

Street Address: 15, Quai Anatole

City: Paris

Country: France

ZIP: 75007

Execution Date: July 23, 1993

Additional name(s) & address(es) attached? ☐ Yes ☒ No

3. Application number(s) or patent number(s):

If this document is being filed together with a new application, the execution date of the application is:

A. Patent Application No(s)

B. Patent No(s)

08470325

Additional numbers attached? ☐ Yes ☒ No

4. Name and address of party to whom correspondence concerning document should be mailed:

Name: Randall A. Hillson

Address: Merchant, Gould, Smith, Edell,
Welter & Schmidt
3100 Northwest Center
90 South Seventh Street
Minneapolis, MN 55402-4131

5. Total number of applications and patents involved: 2

6. Total fee (37 CFR 341): \$4000

☒ Enclosed

☐ Authorized to be charged to deposit account

7. Please charge any additional fees or credit any overpayments to our Deposit account number 13-2725

(A duplicate copy of this page is attached.)

DO NOT USE THIS SPACE

8. Statement and signature.

To the best of my knowledge and belief, the foregoing information is true and correct and any attached copy is a true copy of the original document.

Randall A. Hillson

Name of Person Signing

Signature

Date

Total number of pages including cover sheet: 2

OMB No. 0651-0011 (exp. 4/94)

060 TE 10/19793 08070325

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Mail documents to be recorded with required cover sheet information to:

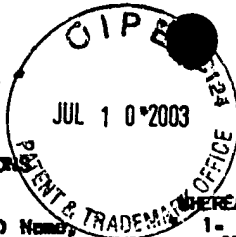
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Public burden reporting for this sample cover sheet is estimated to average about 30 minutes per document to be recorded, including time for reviewing the document and gathering the data needed, and completing and reviewing the sample cover sheet. Send comments regarding this burden estimate to the U.S. Patent and Trademark Office, Office of Information Systems, PM-1000C, Washington, D.C. 20231, and to the Office of Management and Budget, Paperwork Reduction Project (0651-0011), Washington, D.C. 20503.

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ASSIGNMENT TO CORPORATION (FOR USA ONLY)

OCT -4 1993

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*INSTRUCTIONS

Inventor(s) Name

WHEREAS,

1. PERRICAUDET Michel residing at 20, Résidence du Moulin
28150 OUARVILLE (France)

and a citizen of FRANCE

2. BRIAND Pascale residing at 10, rue du Dr Roux
75015 PARIS (France)

and a citizen of FRANCE

3. STRATFORD-PERRICAUDET Leslie residing at 20, Résidence du Moulin
28150 OUARVILLE (France)

and a citizen of FRANCE

Date Patent
Declaration Signed
and Title
Serial No. and Filing

(herein called "THE UNDERSIGNED") have made an invention and have executed an
• for Letters Patent of the United States on _____ for this
• invention, which application is entitled _____
• and which has been given Serial Number _____ and the filing date of _____

Name of Corporation
State or Country of
Incorporation and
Address

AND WHEREAS CENTRE NATIONAL DE LA RECHERCHE SCIENTIFIQUE in

• called "ASSIGNEE"), a corporation organized under the laws of FRANCE
and having an office and place of business at _____
• 15, Quai Anatole France - 75007 PARIS (France)
wishes to acquire the entire right, title and interest in and to said invention
and patent application and any Letters Patent to be obtained therefor;

NOW, THEREFORE, for and in consideration of the sum of One Dollar and other good
and valuable consideration, the receipt and sufficiency of which is hereby acknowle-
dged, THE UNDERSIGNED hereby sell, assign and transfer to the ASSIGNEE, its suc-
cessors and assigns, the entire right, title and interest for all countries in and to
the invention disclosed in the aforesaid application, and in and to the said applica-
tion, all divisions, continuations, or renewals thereof, all Letters Patent which may
be granted therefrom, and all reissues or extensions of such patents, and THE
UNDERSIGNED hereby authorize and request the Commissioner of Patents to issue any and
all United States Letters Patent for the aforesaid invention to the ASSIGNEE of the
entire right, title and interest in and to the same, for the use of the ASSIGNEE, its
successors and assigns.

THE UNDERSIGNED hereby agree that the UNDERSIGNED, their executors and legal
representatives will make, execute and deliver (without charge but at the expense of
the ASSIGNEE) any and all other instruments in writing including any and all further
application papers, affidavits, assignments and other documents, and will communicate
to said ASSIGNEE, its successors and representatives all facts known to the
UNDERSIGNED relating to said invention and the history thereof and will testify in
all legal proceedings and generally do all things which may be necessary or desirable
to vest the ASSIGNEE, its successors or assigns the entire right, title and interest
in and to the said invention, applications, Letters Patent, rights, titles, benefits,
privileges and advantages hereby sold, assigned and conveyed, or intended so to be.

THE UNDERSIGNED represent and agree with said ASSIGNEE its successors and assigns,
that no assignment grant, mortgage, license or other agreement affecting the rights
and property herein conveyed has been or will be made to others by the UNDERSIGNED,
and that full right to convey the same as herein expressed is possessed by the
UNDERSIGNED.

IN TESTIMONY WHEREOF, THE UNDERSIGNED have hereunto set their hand on the dates
indicated below.

Each inventor must
sign & date

Signature M. Perricaudet Date July 23, 1993
Signature P. Briand Date July 23, 1993
Signature Leslie Stratford Perricaudet Date July 23, 1993

Notes: No legalization
or other witness
required

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